

**REMARKS****INTRODUCTION:**

In accordance with the foregoing, claims 3, 4, and 7 have been canceled without prejudice or disclaimer, and claims 1, 2, 5, 6, 9, 10, and 14 have been amended. No new matter is being presented, and approval and entry are respectfully requested.

Claims 1-2, 5-6, and 8-16 are pending and under consideration. Reconsideration is respectfully requested.

**REJECTION UNDER 35 U.S.C. §112:**

In the Office Action, at page 2, claim 7 was rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 7 has been canceled. Hence, the rejection of claim 7 is now moot.

**REJECTION UNDER 35 U.S.C. §§102-103:**

A. In the Office Action, at page 3, claims 1-16 were rejected under 35 U.S.C. §102(b) as being anticipated by Bastiaens et al. (USPN 6,353,050; hereafter, Bastiaens). This rejection is traversed and reconsideration is requested.

Independent claim 1 has been amended for clarity: The terminology "polyester" has been replaced with "(C) poly(ethylene terephthalate) and/or poly(trimethylene terephthalate) and/or poly(butylene terephthalate), which contain no ionic functional group," and the amount has been specified by adding the terminology "wherein the component (C) is contained in an amount of 0.1 to 25 parts by mass based on 100 parts by mass of total amount of the polyamide and the polyphenylene ether." This amendment is supported by, for example, original claims 3 and 4 and lines 24-28 of page 23 of the specification.

Independent claim 14 has been amended for clarity to change the terminology "polyester" to recite "poly(ethylene terephthalate) and/or poly(trimethylene terephthalate) and/or poly(butylene terephthalate), which contain no ionic functional group..".

Claims 3, 4 and 7 have been canceled without prejudice or disclaimer.

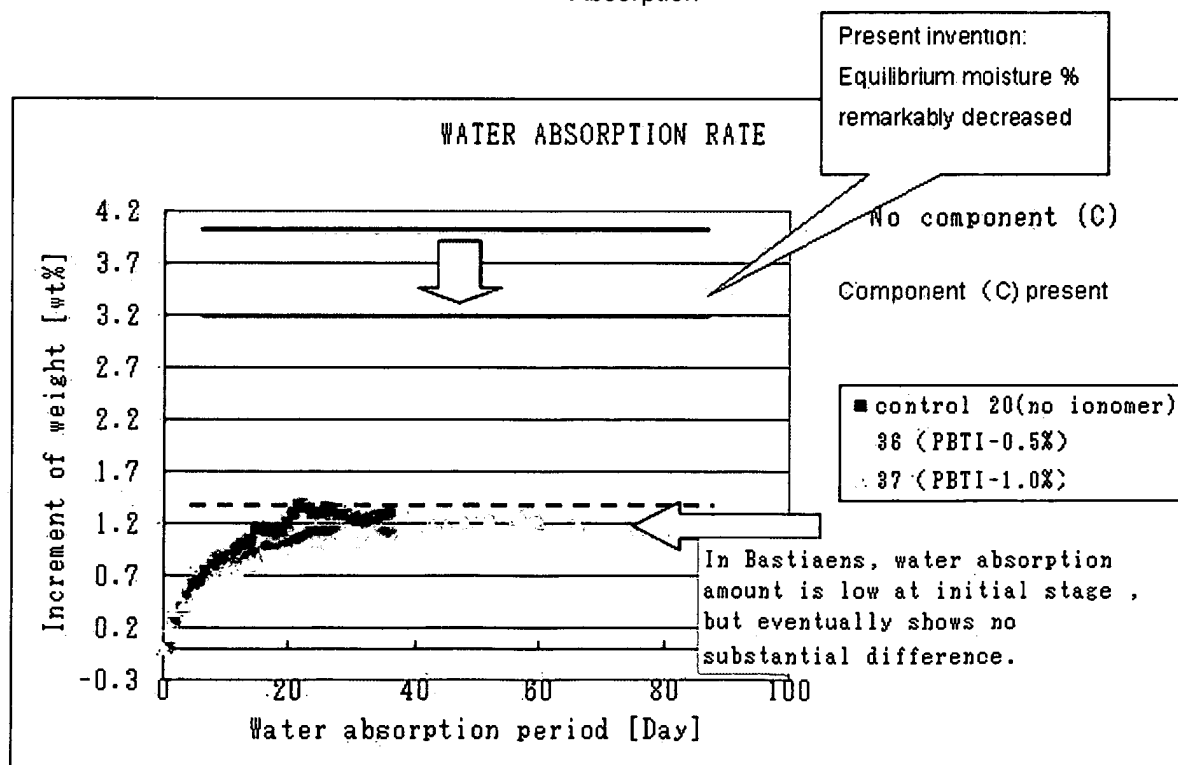
The amendment of the polyester component to "poly(ethylene terephthalate) and/or poly(trimethylene terephthalate) and/or poly(butylene terephthalate), which contain no ionic functional group" is respectfully submitted to show that composition of the present application is different from the resin compositions disclosed in Tables 2 and 3 of Bastiaens.

The water absorption percentages in the present invention and Bastiaens are plotted and compared in the following graph (Fig. A - see below).

In this graph, though the water absorption amount at the initial stage is lower in the examples of Bastiaens than in the comparative examples of Bastiaens, the water absorption in equilibrium state reaches the same level as indicated in broken lines (black) in Fig. A and no distinguished effect is seen between the examples and the comparative examples of Bastiaens.

In contrary, in the present application, the water absorption property is obtained as the amount of water absorbed by immersing a flat molded piece in warm water at 40°C for 750 hours and measuring the difference of the mass before and after the immersion (page 52, lines 5-10 of the specification). The water absorption amount in equilibrium in the present application is remarkably decreased by adding component (C), as shown by blue solid line (in the absence of component (C)) and red solid line (in the presence of component (C)) in Fig. A. The inhibitory effect of water absorption brought about by adding component as in the present application component (C) is excellent as compared to Bastiaens. Further, the present application is excellent in surface luster as well as in a low water absorption property, and thus, is inventive over the prior art.

Fig. A  
Comparison between Present Application and Bastiaens on Effect of Decreasing Water Absorption



It is respectfully submitted that Bastiaens teaches the use of a polyester ionomer, in which constituent monomers have ionic groups (see Abstract of Bastiaens), whereas, on page 23, lines 24-28, it recites that, in the present application "the above-exemplified polyesters preferably contain no ionic functional group." Independent claims 1 and 14 have been amended to show this more clearly. Hence, Bastiaens et al. teaches away from the present application.

Thus, it is respectfully submitted that amended independent claims 1 and 14 are not anticipated by, or rendered obvious in view of, Bastiaens et al. (USPN 6,353,050). Since claims 2, 5-6, and 8-16 depend from amended independent claims 1 and 14, respectively, claims 2, 5-6, and 8-16 are not anticipated by, or rendered obvious in view of, Bastiaens et al. (USPN 6,353,050) for at least the reasons amended independent claims 1 and 14 are not anticipated by, or rendered obvious in view of, Bastiaens et al. (USPN 6,353,050).

**B.** In the Office Action, at page 3, claims 1, 2, and 4-16 were rejected under 35 U.S.C. §102(b) as being anticipated by Miyoshi et al. (US 2003/0116757; hereafter, Miyoshi). This rejection is traversed and reconsideration is requested.

Independent claims 1 and 14 have been amended as set forth above, and claims 4 and 7 have been canceled without prejudice or disclaimer.

Miyoshi discloses a composition requiring PPE, polyamide and impact modifier and carbon filler for electrically conductive uses to which may be added polyester (see paragraph [0077] as well as paragraph [0155]). Independent claim 1 has been amended to specify the species of polyester and the amount thereof blended. Miyoshi only generally mentions the term "polyester" and never describes the species or amount thereof at all.

In addition, Miyoshi is silent about any compositions concomitantly containing the four components (A) to (D) in the present application. Miyoshi is silent about the low water absorption property or good surface luster, which are remarkably advantageous effects of the composition of the present application.

It is respectfully submitted that one of ordinary skill in the art could not have conceived of a particular amount of a particular polyester as recited in amended claim 1 from the general description of Miyoshi, or expected the advantageous effects of the present application that are not mentioned in Miyoshi. Thus, the composition and master batch for a resin composition of the present application are not anticipated and are non-obvious over Miyoshi.

Anticipation requires a lack of novelty of the invention as claimed. The invention must have been known to the art in the detail of the claim; that is, all of the elements and limitations of the claim must be shown in a single prior art reference, arranged as in the claim. See C.R.

Bard, Inc. v. M3 Systems, Inc., 157 F.3d 1340, 1349, 48 USPQ2d 1225, 1229-30 (Fed. Cir. 1998); Richardson v. Suzuki Motor Co., 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

It is respectfully submitted that all of the elements and limitations of the independent claims 1 and 14 are not shown in Miyoshi arranged as in the claims.

Thus, it is respectfully submitted that amended independent claims 1 and 14 are not anticipated by, or rendered obvious in view of, Miyoshi et al. (US 2003/0116757). Since claims 2, 5-6, 8-13 and 15-16 depend from amended independent claims 1 and 14, respectively, claims 2, 5-6, 8-13 and 15-16 are not anticipated by, or rendered obvious in view of, Miyoshi et al. (US 2003/0116757) for at least the reasons amended independent claims 1 and 14 are not anticipated by, or rendered obvious in view of, Miyoshi et al. (US 2003/0116757).

C. In the Office Action, at page 3, claims 1, 2, and 4-16 were rejected under 35 U.S.C. §102(b) as being anticipated by Hossan et al. (US 2002/149006; hereafter, Hossan '006). This rejection is traversed and reconsideration is requested.

Independent claims 1 and 14 have been amended as set forth above, and claims 4 and 7 have been canceled without prejudice or disclaimer.

It appears that the Examiner's position is that Hossan '006 discloses a conductive composition requiring PPE and polyamide, and that polyester may be added. Independent claim 1 has been amended to specify the species of polyester and the amount thereof blended. In Hossan '006 the polyester is mentioned as an impact modifier of "polyester elastomer", which means that the purpose of the addition of polyester is quite different from that in the present application. Further, Hossan '006 describes in paragraph [0042] that ionomer resins are suitable as impact modifiers. The present application requires the incorporation of component (C), i.e., poly(ethylene terephthalate) and/or poly(trimethylene terephthalate) and/or poly(butylene terephthalate), which contain no ionic functional group. Thus, it is respectfully submitted that the composition of the present application is clearly different from that of Hossan '006.

Hossan '006 is silent about the low water absorption property and good surface luster, which are remarkable advantageous effects of the composition of the present application. Even one of ordinary skill in the art could not have conceived of a particular amount of a particular polyester having no ionic functional group as recited in amended claim 1 from the polyester of Hossan '006 "suitably containing ionomer resins". It is respectfully submitted that one of ordinary skill in the art could not have expected the advantageous effects of the composition of the present application that are never mentioned in Hossan '006. Thus, the composition and master batch for a resin composition of the present application are not anticipated and are non-obvious over Hossan '006.

It is respectfully submitted that all of the elements and limitations of the independent claims 1 and 14 are not shown in Hossan '006 arranged as in the claims.

Thus, it is respectfully submitted that amended independent claims 1 and 14 are not anticipated by, or rendered obvious in view of, Hossan et al. (US 2002/149006). Since claims 2, 5-6, 8-13 and 15-16 depend from amended independent claims 1 and 14, respectively, claims 2, 5-6, 8-13 and 15-16 are not anticipated by, or rendered obvious in view of, Hossan et al. (US 2002/149006) for at least the reasons amended independent claims 1 and 14 are not anticipated by, or rendered obvious in view of, Hossan et al. (US 2002/149006).

D. In the Office Action, at page 3, claims 1, 2, and 4-16 were rejected under 35 U.S.C. §102(a or e) as being anticipated by Hossan et al. (US 2004 /0238793; Hossan '793). This rejection is traversed and reconsideration is requested.

Independent claims 1 and 14 have been amended as set forth above, and claims 4 and 7 have been canceled without prejudice or disclaimer.

It appears that it is the Examiner's position that Hossan '793 discloses a composition requiring PPE, polyamide and electrically conducting carbon black and which may be formed from a polyester/carbon black masterbatch. Independent claim 1 has been amended to specify the species of polyester and the amount thereof blended. Hossan '793 only generally mentions the term "polyester" and never describes the species or amount thereof at all. In addition, Hossan '793 is silent about any compositions concomitantly containing the four components (A) to (D) in the present application.

Hossan'793 is silent about the low water absorption property and good surface luster, which are remarkable advantageous effects of the composition of the present application. It is respectfully submitted that one of ordinary skill in the art could not have conceived of a particular amount of a particular polyester as recited in amended claim 1 from the general description of Hossan '793, or expected the advantageous effects of the composition and master batch for a resin composition of the present application that are never mentioned in Hossan '793. Thus, the composition and master batch for a resin composition of the present application are not anticipated and are non-obvious over Hossan '793.

It is respectfully submitted that all of the elements and limitations of the independent claims 1 and 14 are not shown in Hossan '793 arranged as in the claims.

Thus, it is respectfully submitted that amended independent claims 1 and 14 are not anticipated by, or rendered obvious in view of, Hossan et al. (US 2004 /0238793). Since claims 2, 5-6, 8-13 and 15-16 depend from amended independent claims 1 and 14, respectively, claims 2, 5-6, 8-13 and 15-16 are not anticipated by, or rendered obvious in view of, Hossan et al. (US

2004 /0238793) for at least the reasons amended independent claims 1 and 14 are not anticipated by, or rendered obvious in view of, Hossan et al. (US 2004 /0238793).

E. In the Office Action, at page 4, claims 1-16 were rejected under 35 U.S.C. §103(a) as being unpatentable over Takagi et al. (US 2003/0130405; hereafter, Takagi). This rejection is traversed and reconsideration is requested.

Independent claims 1 and 14 have been amended as set forth above, and claims 4 and 7 have been canceled without prejudice or disclaimer.

The Examiner states that there are no examples in which all of applicants' materials are present in combination, but submits that it would have been obvious to a practitioner having ordinary skill in the art to arrive at applicants' composition by selecting from the various disclosures of Takagi. It is respectfully submitted that, in hindsight, an argument can be made that combining references would provide the claimed invention. Generally, the purpose in combining references is not to show that the combination will worsen or degrade a feature.

However, it is respectfully submitted that the Examiner "can satisfy the burden of obviousness in light of combination 'only by showing some objective teaching [leading to the combination].'" In re Dembiczak, 50 USPQ2d 1614, 1617 (CAFC 1999), *quoting In re Fritch*, 23 USPQ2d 1780, 1783 (Fed. Cir. 1992). It is submitted that KSR International Co. v. Teleflex Inc., 127 S. Ct. 1727 (2007), recognized the value of that test in determining whether the prior art provided a reason for one of skill in the art to make the claimed combination. Thus, it remains necessary to identify some reason that would have led one skilled in the art to modify an invention in a particular manner to establish prima facie obviousness of a new claimed invention. It is respectfully submitted that no such reason has been set forth by the Examiner. To the extent an art is unpredictable, as the chemical arts often are, it is respectfully submitted that KSR's requirement of "identified, predictable solutions" is not met because potential solutions are not likely to be genuinely predictable.

Independent claim 1 has been amended to specify the species of polyester and the amount thereof blended. Takagi describes a resin composition comprising two different thermoplastic resins, conductive carbon black and hollow carbon fibril, wherein one thermoplastic resin is PPE and the other thermoplastic resin is polyamide or polyester. This means that the polyester is not an essential component in the resin composition of Takagi and hence, Takagi is quite different from the composition of the present invention. Therefore, Takagi is quite silent about specific species or blended amount of polyester, and also silent about any advantageous effect brought about by the incorporation of polyester. It is respectfully submitted that one of ordinary skill in the art could not have conceived of a particular amount of a particular polyester from the general description of Takagi. Even one of ordinary skill in the art could not

have expected the advantageous effects of the composition and master batch for a resin composition of the present application that are never mentioned in Takagi.

In addition, it is clear that the inhibitory effect of water absorption property in the composition and master batch for a resin composition of the present application are excellent. The advantage of surface luster can be clearly read from the Examples of the specification.

Thus, amended independent claims 1 and 14 are respectfully submitted to be patentable under 35 U.S.C. §103(a) over Takagi et al. (US 2003/0130405). Since claims 2, 5-6, and 8-16 depend from amended independent claims 1 and 14, respectively, claims 2, 5-6, and 8-16 are patentable under 35 U.S.C. §103(a) over Takagi et al. (US 2003/0130405) for at least the reasons amended independent claims 1 and 14 are patentable 35 U.S.C. §103(a) over Takagi et al. (US 2003/0130405).

#### CONCLUSION:

In accordance with the foregoing, it is respectfully submitted that all outstanding objections and rejections have been overcome and/or rendered moot, and further, that all pending claims patentably distinguish over the prior art. Thus, there being no further outstanding objections or rejections, the application is submitted as being in condition for allowance which action is earnestly solicited.

If the Examiner has any remaining issues to be addressed, it is believed that prosecution can be expedited by the Examiner contacting the undersigned attorney for a telephone interview to discuss resolution of such issues.

If there are any underpayments or overpayments of fees associated with the filing of this Amendment, please charge and/or credit the same to our Deposit Account No. 19-3935.

Respectfully submitted,

STAAS & HALSEY LLP

Date:

December 19, 2008

By:

Darleen J. Stockley  
Darleen J. Stockley  
Registration No. 34,257

1201 New York Avenue, N.W.  
7th Floor  
Washington, D.C. 20005  
Telephone: (202) 434-1500  
Facsimile: (202) 434-1501